

R E M A R K S

Applicant has carefully considered the Office Action of July 21, 2000 rejecting all of the claims. Applicant wishes to express his appreciation to the Examiner for the interviews conducted with the undersigned, Applicant's attorney, on May 22, 2000 and November 21, 2000. The Applicant also wishes to express his appreciation to the Examiner for the indication of allowable subject matter.

The present response is intended to implement the conclusions of the interview and be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

The present application is the National Stage of PCT patent application PCT/US96/01209.

At the outset, it was agreed upon in the interview that the finality of the last Office Action is withdrawn.

The Applicant wishes to correct a typographical error appearing in the Remarks of the previous response, submitted April 30, 1999. On page 10, lines 6-7, the text should read "...therefore Pipes does not anticipate the claims under Sec. 102(b)".

It is requested that a requirement for formal drawing corrections be held in abeyance until an indication of allowance has been received.

Claims 1, 19, 26-29 and 48 have been amended. Thus, claims 1-49 remain in the case.

For the Examiner's convenience, and as a quick review, it is re-stated that the object of the present invention is to overcome the problems of existing products exhibiting telescopic movement. The invention provides a system of telescopic elements for multiplying

the effective physical work achieved by simple hand and leg movements, in controlling the telescopic motion of various structures and their length. The invention is applicable in many varied fields including cleaning systems, vacuum cleaners, measuring rods, tools, paint rollers, wall scrapers, music stands and instruments, parasols, shades, curtains, sailing boat masts, and structures such as chairs, tripods, tables, tents etc.

As amended, independent claim 1 indicates that the driving and driven motions of the system elements occur simultaneously, that the elements are hand-holdable, and that the driven motion is non-gravity dependent. Further, as was previously explained, the motion is controllably reversible, such that both extension and retraction motions are under full, reversible and multipliable control of the mechanism.

In addition, claim 1 has been further amended to indicate that the motion of the elements is in-line with their orientation, achieving linear-to-linear motion.

The Examiner is referred to the previously filed Remarks indicating examples of this motion, described in the text, with reference to Figs. 1-6. The examples describe hand motion applied to develop driving motion between the first and second elements, and the linking means (loop), resulting in two types of extension and retraction motion, with driving and driven motions either in the same, or in reverse directions, as per claim 4.

The advantage of this operation is described in the text at page 8, last paragraph, through page 9, line 12, with reference to Figs. 1-6. In one case, where the operating hand moves the handle opposite the motion of segment 106, the user reaches greater distances, "which is good for working at heights..." In another case, where the operating hand moves in the same direction as the segment 104, this arrangement is "effective for working in lower places". Thus, it can be seen that the

inventive tool solves a particular problem at high and low locations, and it is solved by this unique motion.

Thus, as per amended claim 1, the ability to control multipliable driven motion, via simultaneous motion of segments during extension or retraction, via non-gravity dependent linear-to-linear movement, gives the present invention an advantage over other telescopic systems.

The Examiner has rejected independent claim 1 and the various groupings of certain dependent claims under Sec. 102(b) as being anticipated by Steidle. The Examiner has also rejected claim 3 under Sec. 103(a) as being unpatentable over Steidle.

The Steidle reference describes a telescoping tower, which is operated by pneumatically-driven motion of individual sections, which are "elevated in succession", not simultaneously, as per page 1, line 29. The collapse of these sections depends on gravity, so that it is weight-driven, and is not controllably reversible. Further, the motion of the sections is dependent on the use of a spring drum 53, which is the motion mechanism, and is not "in-line" with the sections. This motion is rotational-to-linear motion, not linear-to-linear motion. The construction is heavy and requires a supporting base.

In contrast, the present invention describes a motion transmission system in which the elements move simultaneously, with controllably reversible motion, in a hand-holdable system, operated from either end of the construction, without a requirement for a base to support the elements. The motion of the linking means is adjustably multipliable, with the linking means adjustably arranged on the elements, as can be seen in Figs. 10-15b, 22, 24, and 30, etc. The system of the invention is not dependent on gravity for the re-inserting the elements one within the other, while Steidle uses gravity, and hand rotation of the drum 53, as the sections collapse and the air escapes. As conceded

by the Examiner in the Office Action, Steidle cannot provide driven and driving motion in opposite directions.

Applicant respectfully disagrees with the Examiner's statement that the directions of motion are a matter of "design choice". As stated above in these remarks, the ability to reverse these motions gives the present invention the advantage of having a design which solves the problems of reaching both high and low areas. Since the particular problems solved by the invention cannot be solved by the Steidle design, there is really no "design choice" which would have brought about these solutions.

It is respectfully maintained by the Applicant that the functional interpretation and applicability of the Steidle reference vs. the pending claims is a matter to be decided by the Patent Office, and ultimately, the courts, and any choice made now by the Applicant may be prejudicial to legal issues if these should arise in the future. Therefore, Applicant respectfully declines the opportunity to choose a basis for means-plus-function claim interpretation, but clearly, the intent is to achieve the broadest claims possible, as allowed by law.

Since the concept of the invention has many and varied applications, some of which may be developed in the future, Applicant wishes to have the broadest claim possible to allow for claim coverage wherever applicable.

There is no disclosure in Steidle of simultaneous, controllably reversible, linear-to-linear, non-gravity dependent motion of hand-holdable segments in line with the orientation direction, which is provided by the present invention as now claimed by the amendments to independent claim 1. Therefore, Steidle does not anticipate the claims under Sec. 102(b).

As stated in the decision in In Re Marshall, 198 USPQ 344 (1978), "To constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art...". Since Steidle neither 1)

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identically describes the invention nor 2) enables one skilled in the art to practice it, Applicant deems the 102(b) rejection improper, and respectfully requests that it be withdrawn.

The provision by the present invention of reversible directions of driving and driven motions is deemed not to have been obvious, and is not a design choice, since the teaching of Steidle does not disclose this, nor does it disclose a device like that of the present invention.

In citing the Steidle reference under Sec. 103(a), the question is raised whether the reference itself would suggest the invention, as stated in the decision of In Re Lintner (172 USPQ 560, 562, CCPA 1972):

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination other modification."

Similarly, In Re Regel (188 USPQ 136 CCPA 1975) decided that the question raised under Sec. 103 is whether the prior art taken as a whole would suggest the claimed invention to one of ordinary skill in the art. Accordingly, even if all the elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Simply put, and as stated in In re Clinton (188 USPQ 365 CCPA 1976), "do the references themselves ... suggest doing what appellants have done", such that there is a requirement that the prior art must have made

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any proposed modification or changes in the prior art obvious to do, rather than obvious to try.

It is respectfully put forward by Applicant that there is not any substantial reason to view the Steidle reference as making the invention obvious, since it does not suggest reversible directions of driving and driven motions, as provided by the invention. To say that this feature is obvious to try, or a design choice, as the Examiner seems to do, is one thing, but to recognize the above-outlined design advantages is another thing.

Therefore, independent claim 1 is deemed to be patentable over the prior art, and the dependent claims are likewise deemed patentable being based thereon.

In view of the foregoing amendments and remarks, all of the claims remaining in the application are deemed to be allowable. Further reconsideration and allowance of the application is respectfully requested at an early date.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Edward Langer", is written over the typed name.

Edward Langer, Attorney

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